UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,885	05/04/2001	Michael Epstein	US 000140	8744

24737   7590   03/05/2008
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER
DINH, MINH

ART UNIT	PAPER NUMBER
2132	

MAIL DATE	DELIVERY MODE
03/05/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

———————

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

———————

Ex parte MICHAEL EPSTEIN and MARTIN ROSNER

———————

Appeal 2007-2112
Application 09/848,885
Technology Center 2100

———————

Decided: March 5, 2008

———————

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
JOHN A. JEFFERY, Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's final rejection of claims 1-23. We have jurisdiction under
35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to the field of consumer electronics and protection of copy-protected content material, including music (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. A system that is configured to receive one or more select data items of a plurality of data items corresponding to a data set, comprising:
>
> a verifier that is configured to provide a verification of a presence of the data set, via:
>
> a first verification of a presence of a select subset of the plurality of data items, and
>
> a second verification of a receipt of a given proportion of the plurality of data items, and
>
> wherein the verifier provides the verification of the presence of the data set if either the first verification or the second verification occurs.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Serret-Avila	6,785,815 B1	Aug. 31, 2004
Oshima	6,266,299 B1	Jul. 24, 2001

REJECTIONS

Claims 1-7, 18 and 20-23 stand rejected under 35 U.S.C. § 102 as being unpatentable over Serret-Avila.

Claims 8-17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Serret-Avila in view of Oshima.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejections, we make reference to the Examiner's Answer (mailed March 27, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed January 9, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

"It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless

inherent in it. . . . Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

"[A] prima facie case of anticipation [may be] based on inherency." *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product."). *See also In re Spada*, 911 F.2d 705, 708 09 (Fed. Cir. 1990).

The issue we decide is: Has the Examiner set forth a prima facie case of anticipation of independent claims 1 and 18?

Here, the Examiner maintains that Serret-Avila teaches both a first verification of a presence of a selected subset of the plurality of data items as taught in figures 9A and 9B and a second verification of a receipt of all of the plurality of data items (figures 10-11), wherein the verifier provides the

4

verification of the presence of the data set if either the first verification or the second verification occurs (figure 11). (Answer 3-4). In the responsive arguments section of the Brief, the Examiner further details how Serret-Avila teaches the recited limitations of independent claim 1 (Ans. 8-11). The Examiner emphasizes that a song which is partitioned as a data set is a reasonable interpretation by one of ordinary skill in the art as recited in the language of independent claim 1. The Examiner maintains that Serret-Avila teaches verifying the presence of each data block/item of a received data set. The Examiner maintains that this verifying of the presence of each and every data block of the data set (song) of Serret-Avila verifies the presence of the whole data set.

The Examiner further maintains that Serret-Avila also discloses verifying whether the received data set is a valid data set by verifying that certain data items designated as mark-holders that actually contain strong watermarks are present, and verifying if these mark-holders exist by analyzing the content of supposed mark-holders. The Examiner concludes that by verifying whether the received data set is a valid set, Serret-Avila also verifies the presence of the data set (Ans. 9).

While we agree with the Examiner's creative interpretation of the teachings of Serret-Avila with respect to a verification of the presence of a data set, we cannot agree with the Examiner that this would be a verification of a presence of a select subset of the plurality of data items.

Rather, we agree with Appellants that the interpretation of Serret-Avila can only be reasonably interpreted to teach a verification of only those data sets actually received by the receiver (Br. 5). We cannot agree with the

5

Examiner that this would have been a verification of the presence of a select subset. Therefore, we agree with Appellants, and we find that Serret-Avila does not teach verifying the presence of the subset, but does teach verifying the presence of a watermark in a given subset (Br. 6). Therefore, we find the Examiner's interpretation of the teachings of Serret-Avila to be attenuated and unreasonable in light of the disclosure of Serret-Avila.

While we agree with the Examiner's various individual interpretations of discrete portions of the teachings of Serret-Avila for distinct portions of the claim limitations, we do not find that the totality of the interpretations advanced by the Examiner are reasonable when the claimed invention is interpreted as a whole.

Additionally, with respect to the Examiner's interpretation of Serret-Avila with respect to the claim limitation for verification of the receipt of a given proportion of a plurality of data items, the Examiner relies upon the sequential verification of multiple blocks in a larger data set and relies upon figures 10 and 11 of Serret-Avila (Answer 3-4). Here, the Examiner's interpretation may be reasonable, but the Examiner has not identified any express teachings to support this position. In the responsive arguments, the Examiner identifies figure 11 in the decoding process as teaching the limitation, but then relies upon the discussion of figure 10 with respect to partitioning the data into blocks during the encoding process in figure 10 (Ans. 10-11). While we may speculate as to the overall decoding process in light of the teachings of the encoding process, we find no express teachings in Serret-Avila concerning receipt of a given portion of a plurality of data

items, and the Examiner has not specifically identified a reasoned teaching for this limitation.

Here, it appears that the Examiner has a generalized and segmented application of the prior art reference to Serret-Avila with respect to the claimed invention, but we do not find that the teachings of Serret-Avila clearly teach the whole invention recited in the language independent claim 1. Therefore, we will not sustain the anticipation rejection of independent claim 1 and its respective dependent claims 2-7.

With respect to independent claim 18, the Examiner summarily addresses this claim as the same scope as independent claim 1 (Br. 11). We similarly find that the Examiner has failed to meet the initial burden of establishing anticipation of independent claim 18 over Serret-Avila for the same reasons discussed above. Additionally, we do not find that Serret-Avila teaches conducting a first test for a presence of an entirety of the data set based on a receipt of randomly selected sections of the data set as recited in independent claim 18. Therefore, we will not sustain the anticipation rejection of independent claim 18 and its dependent claims 20 -23.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d

1443, 1445 (Fed. Cir. 1992). Furthermore, "'there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness' . . . however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

From our review of the teachings of Oshima as applied by the Examiner concerning the data set identifier, we do not find that the teachings of Oshima remedy the deficiency noted above with regard to Serret-Avila. Therefore, we cannot sustain the obviousness rejection of dependent claims 8-17 and 19.

CONCLUSION

To summarize, we have reversed the rejection of claims 1-7, 18, and 20-23 under 35 U.S.C. § 102, and we have reversed the rejection of claims 8-17 and 19 under 35 U.S.C. § 103(a).

REVERSED

clj

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510